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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,132	02/12/2002	Scott Frederick Ansell	VTN-0577	8163
27777	7590	03/16/2004	EXAMINER HECKENBERG JR, DONALD H	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			ART UNIT 1722	PAPER NUMBER

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/074,132	ANSELL ET AL.
	Examiner	Art Unit
	Donald Heckenberg	1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 October 2003 and 01 December 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-50 is/are pending in the application.
- 4a) Of the above claim(s) 50 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-49 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 February 2002 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

1. Newly submitted claim 50 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The apparatus of claim 50 and that of the originally claimed (as well as that of the currently amended claims with the exception of claim 50) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. MPEP § 806.05(c). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require an overflow collector. The subcombination has separate utility such as be used to mold lenses wherein the mold portion in the region exterior to the radial edge does have lens material.

Since Applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 50 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 21-23, 25-28, 30-37, 39-40, 44, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Doke et al. (U.S. Pat. No. 6,071,111; previously of record).

Doke discloses an optical lens molding apparatus, including an embodiment shown in figure 18. The mold comprises a first mold portion (2) which comprises a concave optical surface (see figure 18). The first mold also comprises an edge (24) and a first flange (22). A second mold portion (4) comprises a convex surface (see figure 18). The second mold portion also comprises a second flange (14). The first flange of the first mold portion opposes the second flange of the second mold portion such that a gap open to the ambient environment is formed

between the two flanges (see figure 18). The first flange is provided with an overflow collector with a protrusion structure (18), the overflow collector being capable of accumulating overflow reactive mixture (col. 16, ll. 29-32). The overflow collector is inserted between flanges of the first and second mold portions, and the overflow collector forms a ring around the mold (see figure 18). The protrusion structure also forms a ring around the mold (figure 18). The overflow collector is part of a separate structure (6) which is removable from the mold. Doke additionally notes that the lower portions of the mold (2), which includes the overflow collector (6) and protrusion structure (18), are made from polystyrene (col. 8, ll. 17-25).

Claims 31 and 34 both recite that the overflow collector comprises a structure facing one of the flanges, and that the overflow collector is such that it is capable of reducing the surface area of the overflow reactive mixture in contact with the ambient or inert environment by more than 25 percent as compared to an overflow collector absent such a structure (the structure being a depression or protrusion in claim 34). This limitation is, in part, dependent on the intended use of the apparatus. Specifically, different molding materials will have different amounts of surface area exposed to inert environment

depending on how much the material spreads out if the structure was not provided, the spreading being dependent on the viscosity of the particular molding material used. Yet, the particular molding material used is not part of the apparatus structure, but rather simply part of the intended use of the claimed apparatus. It should be noted that it is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. Moreover, claims 31 and 34 are both written as the structure being "capable of" reducing surface area, not that the structure necessarily does for every given molding material.

Doke provides the overflow collector with a protrusion structure (18) facing the second flange. The protrusion structure it placed on the apparatus as such that it prevents the excess molding material from spreading out over the length of the flange (22). Thus, the apparatus disclosed by Doke is capable of reducing the surface area of the overflow reactive mixture in contact with the ambient or inert environment by more than 25 percent, or even 50 percent, as compared to the overflow

collector with the overflow collector absent the protrusion structure in cases where low viscosity molding materials which would widely spread out over the flange. As Doke's apparatus is capable of performing this claimed use, it meets the claim limitation directed at reducing the surface area of molding material exposed to the ambient environment.

Claims 22, 27, 30, and 33 also recite limitations directed towards the intended use of the apparatus, specifically, that the apparatus is reusable or disposable. The structure of the apparatus disclosed by Doke is such that upon completion of the curing of the mold material, the product is removed from the mold (see for example, col. 5, l. 61 - col. 6, l. 13). At this point, the mold could either be used again, or disposed of. Thus, the apparatus of Doke is capable of being reusable or disposable, and anticipates the claims reciting such limitations.

4. Claims 21-22, 31, 34, 37, and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Ihn et al. (U.S. Pat. No. 4,865,779; previously of record).

Ihn discloses a lens molding apparatus. The apparatus comprises a first mold portion (10) comprising a concave optical surface (16), an edge (32), and a first flange (including

structure 14). The apparatus also comprises a second mold portion (12) comprising a convex surface (38) and a second flange (including structures 44 and 46) opposing the first flange (see figure 2). A gap is situated between the flanges and the gap is open to the ambient environment (figure 1). The second flange comprises a depression that, together with the flanges, forms an overflow collector (20) comprising a volume capable of accumulating overflow reactive mixture (see figure 3 and col. 4, ll. 19-23).

Claims 31 and 34 both recite that the overflow collector comprises a structure facing one of the flanges, and that the overflow collector is such that it is capable of reducing the surface area of the overflow reactive mixture in contact with the ambient or inert environment by more than 25 percent as compared to an overflow collector absent such a structure (the structure being a depression or protrusion in claim 34). As noted above in the rejection based on the Doke reference, this limitation is, in part, dependent on the intended use of the apparatus, specifically the characteristics of the molding material used.

Ihn provides the overflow collector with a depression structure (figure 3). The depression structure is placed on the apparatus as such that it collects some of the excess molding

material. As such, the apparatus disclosed by Ihn is capable of reducing the surface area of the overflow reactive mixture in contact with the ambient or inert environment by more than 25 percent, or even 50 percent, as compared to the overflow collector with the overflow collector absent the depression structure in cases where a specific quantity of molding material is used such that without the depression, molding material would spill out of the gap between the two molds and be exposed to the ambient environment (see figure 2). As Ihn's apparatus is capable of performing this claimed use, it meets the claim limitation directed at reducing the surface area of molding material exposed to the ambient environment.

Claim 22 also recites a limitation directed towards the intended use of the apparatus, specifically, that the apparatus is reusable or disposable. The structure of the apparatus disclosed by Ihn is such that upon completion of the curing of the mold material, the product is removed from the mold (see for example, col. 5, ll. 13-17). At this point, the mold could either be used again, or disposed of. Thus, the apparatus of Ihn is capable of being reusable or disposable, and anticipates the claims reciting such limitations.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that

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was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doke in view of Appleton et al. (U.S. Pat. No. 5,271,875; previously of record).

Doke discloses the molding apparatus as described above, including the overflow collector being made from polystyrene. Doke does not disclose however the overflow collector to comprise a rubber or sponge material.

Appleton discloses an optical lens molding apparatus. Appleton notes that the apparatus could be made from polystyrene, or in alternative, the mold could be made from a rubber material, as both of these materials have properties advantageous in the molding process (col. 6, ll. 4-29).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus of Doke as such to have used a rubber material for the overflow collect because rubber is an alternative material to polystyrene which is advantageous in the molding process as suggested by Appleton.

9. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doke in view of Shepherd (U.S. Pat. No. 4,121,896; previously of record).

Doke discloses the optical lens molding apparatus which, as noted above, comprises a first mold portion comprising a concave optical surface, and a second mold portion comprising a convex optical surface. Based on these two structures, first and second flange members with corresponding structures can be seen in the apparatus of Doke. For example, the configuration is such that first flange (22) comprises the protrusion structure (18). Thus, Doke does not show the second flange to comprise the protrusion.

Shepherd discloses an apparatus for molding optical lenses. As shown in figures 1-4, Shepherd discloses the configuration of the apparatus is such that the convex and concave surfaces can be reversed, that is, a first mold portion (114) can be convex (figure 1), or alternatively the first mold portion can be concave (figure 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Doke as such to alternate the first and second mold portions being convex and concave because, as

Sheperd discloses, the two configurations are alternatives of each other which still allow for the optical lenses to be molded. Thus, in a modified configuration of Doke wherein the mold portion designated as (2) was convex, this mold portion would be the second mold portion, and its flange (22) would be the second flange comprising the protrusion (18).

10. Claims 38 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihn in view of Shepherd.

Ihn discloses the apparatus which, as noted above, comprises a first mold portion comprising a concave optical surface, and a second mold portion comprising a convex optical surface. Based on these two structures, first and second flange members with corresponding structures can be seen in the apparatus of Ihn. For example, the configuration is such that first flange comprises the depression structure (see figure 3). Thus, Ihn does not show the first flange to comprise the protrusion.

Shepherd discloses an apparatus for molding optical lenses. As shown in figures 1-4, Shepherd discloses the configuration of the apparatus is such that the convex and concave surfaces can be reversed, that is, a first mold portion (114) can be convex

(figure 1), or alternatively the first mold portion can be concave (figure 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Ihn as such to alternate the first and second mold portions being convex and concave because, as Sheperd discloses, the two configurations are alternatives of each other which still allow for the optical lenses to be molded. Thus, in a modified configuration of Ihn wherein the mold portion designated as (10) was convex, this mold portion would be the second mold portion, and its flange would be the second flange comprising the depression.

With respect to claims 45-46, because of the shape of the depression disclosed by Ihn, the area of the overflow collector in the mold portion with the depression which contacts the overflow molding material is larger than the area of the contact surface of the mold portion not comprising the overflow collector (see figure 3). Therefore, when a molding material is used that sticks to the overflow collector surfaces, the molding material will preferentially adhere to the mold portion with the depression because of its greater surface area.

11. Claims 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihn in view of Adams et al. (U.S. Pat. No. 5,326,505; previously of record).

Ihn discloses the apparatus as described above. Ihn does not disclose the overflow collector's first mold portion contact surface or the overflow collector's second mold portion contact surface to comprise a material that is different from the concave or convex optical surfaces.

Adams discloses an optical lens molding apparatus. In the apparatus, the contact surface (28) of the overflow collector region is made different through the use of corona treatment (figure 4 & col. 3, l. 56 - col. 4, l. 7). This allows for the excess molding material (44) to adhere to the to the treated mold piece (col. 2, ll. 20-30).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Ihn as such to have made the material of the contact surface of the overflow collector different through the use of corona treatment because this would make the excess molding material adhere to the mold piece as desired. One of ordinary skill in the art could provide this on the first or second contact surfaces depending on the desired result, and thus intended use of the apparatus.

12. Applicants' arguments filed October 15, 2003 have been fully considered but they are not persuasive.

Many of Applicants' are moot in view of the withdrawal of the previous rejections and presentation of the new grounds of rejection set forth above. However, with respect to the Doke reference, Applicants argue that (in the embodiment shown in figure 18), the flange labeled 22 is separate from either the upper or lower mold half. While the flange is "separate" as shown in the figure, Doke notes that this structure is part of the lower mold half (see col. 8, ll. 13-15). Moreover, none of the claim language of the instant application distinguishes over the arrangement shown in Doke. Doke therefore anticipates the reference as set forth above. In fact in anything claim 25 implies that the overflow collector is a separate structure in noting the overflow collector is removable from the mold.

13. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
March 2, 2004


JAMES P. MACKEY
PRIMARY EXAMINER

3/4/04